

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

(Attorney Docket No. 14206US03)

In the Application of:

Charles Gollnick et al.

U.S. Patent: 7,826,818

Issue Date: November 2, 2010

Serial No.: 10/657,785

Filed: September 8, 2003

**For: NETWORK SUPPORTING
ROAMING, SLEEPING TERMINALS**

Examiner: Philip Sobutka

Group Art Unit: 2618

Confirmation No.: 1344

Transmitted via the Office electronic filing
system **January 3, 2011.**

**APPLICATION FOR RECONSIDERATION OF THE
PATENT TERM ADJUSTMENT UNDER 35 U.S.C. § 154(b)
INDICATED IN THE PATENT (37 CFR § 1.705(d))**

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Sir:

The Applicant respectfully requests reconsideration of the patent term adjustment indicated on the cover page of the patent ("the patent PTA decision"), to the extent indicated in the following discussion and the enclosed modified version of the current USPTO Patent Term Adjustment calculation on PAIR ("The Spreadsheet"). The spreadsheet and the total PTAs indicated in this paper also reflect aspects of the current USPTO Patent Term Adjustment calculation on PAIR that have already been the subject of an earlier request for recalculation under 37 CFR § 1.705(b).

This application for reconsideration of the patent PTA decision is being filed within two months after the patent issue date.

This application for reconsideration of the patent PTA decision is accompanied by the fee set forth in § 1.18(e) (\$200).

This application for reconsideration of the patent PTA decision includes below a statement of the facts involved in sufficient detail to allow the United States Patent and Trademark Office (USPTO) to reach the correct patent term adjustment respecting the disputed items that arose after allowance.

The Applicant's calculation shows that the correct patent term adjustment, accounting for previously disputed and presently disputed items, should be 1190 days.

The basis under § 1.702 and 37 CFR § 1.705(d) for the adjustment is as follows.

Positive Patent Term Adjustment

Three Year Guarantee (35 USC § 154(b)(1)(B))

The following calculation of the patent term adjustment under the three year guarantee (35 USC § 154(b)(1)(B)), first presented after the issue date of the patent, is timely because:

The USPTO does not calculate and inform the Applicant of the patent term adjustment based upon the three-year pendency provision of 35 U.S.C. § 154(b)(1)(B) in the notice of allowance because the USPTO must know the date the patent will issue to be able to calculate the patent term adjustment based upon this provision. Thus, reconsideration of the patent term adjustment indicated in the patent as it relates to the three-year pendency provision of 35 U.S.C. § 154(b)(1)(B) is not considered a matter that could have been raised in an application for patent term adjustment under 37 CFR 1.705(b) (provides for reconsideration of the patent term adjustment indicated in the notice of allowance). Therefore, a request for reconsideration of the patent term adjustment calculation based on the three-year pendency provision of 35 U.S.C. § 154(b)(1)(B) will be considered timely under 37 CFR 1.705(d) if filed within two months of the date the patent issued.

1347 OG 49 (*Notice Concerning Calculation of the Patent Term Adjustment under 35 U.S.C. § 154(b)(1)(B) involving International Applications Entering the National Stage Pursuant to 35 U.S.C. § 371*), October 6, 2009.

The USPTO calculation of the patent term adjustment under the three-year deadline for issuing a patent after its filing date was 1111 days. The Applicant disagrees with this determination because the patent term adjustment on this ground should instead be 1112 days, minus 0 days consumed by an appeal, for a net adjustment of 1112 days.

Specifically, the enclosed modified version of the USPTO Patent Term Adjustment calculation on PAIR shows that:

- the actual filing date of the application was September 8, 2003,
- the third anniversary of the actual filing date was September 8, 2006,
- the first request for continued examination of the application (RCE) under 35 USC 132(b) was filed on September 24, 2009,
- the first RCE was filed 1112 days after the third anniversary of the actual filing date, which is the appropriate patent term adjustment on this ground.

The USPTO has established a rule respecting the endpoint of the delay under the three-year rule resulting from the filing of a request for continued examination ("RCE"): 37 CFR § 1.703(b), which states:

The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the following periods:

(1) The number of days, if any, in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued.

In short, the USPTO's position on this point is effectively that the patent term adjustment under the Three Year Guarantee (35 USC § 154(b)(1)(B)) ends on the day before the first RCE is filed. The rationale is that the day the RCE is filed is Day 1 that the patent term adjustment has stopped accumulating.

The Applicant respectfully submits that this position is inconsistent with the statute and other USPTO calculations based on events that interrupt the accumulation of patent term adjustments.

First addressing consistency with the statute, the USPTO has determined that time for purposes of assessing a PTA is calculated in two ways: one way when the statute calls for calculation of a delay or interval between two events, and the other way when the statute calls for calculation of the number of days on which a proceeding is pending. This differentiation between the two calculations is understood to turn on the words of the statute. The only part of the statute that calls for a determination of the number of days on which a proceeding is pending is 35 USC § 154(b)(1)(C), which states:

35 USC § 154(b)(1)(C) GUARANTEE OR ADJUSTMENTS FOR DELAYS DUE TO INTERFERENCES, SECRECY ORDERS, AND APPEALS.- Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to-

(i) a proceeding under section 135(a);

(ii) the imposition of an order under section 181; or

(iii) appellate review by the Board of Patent Appeals and Interferences or by a Federal court in a case in which the patent was issued under a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended 1 day for each day of the pendency of the proceeding, order, or review, as the case may be.

To provide a simple example, if an appeal were filed on Monday and decided on Friday, the appellate review was pending on Monday, Tuesday, Wednesday, Thursday, and Friday, thus on five days.

In contrast, the part of the statute relevant to an RCE capping the accrual of a PTA under the three year guarantee is 35 USC § 154(b)(1)(B), which states:

35 USC § 154(b)(1)(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY.- Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including-

(i) any time consumed by continued examination of the application requested by the Applicant under section 132(b);

(ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or

(iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the Applicant except as permitted by paragraph (3)(C),

the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

Reverting again to the above simple example, if an appeal were filed on Monday and decided on Friday, the “time consumed by appellate review” is calculated by setting Monday equal to Day 0, Tuesday equal to Day 1, Wednesday equal to Day 2, Thursday equal to Day 3, and Friday equal 4, thus an elapsed time of FOUR, days, not FIVE as in the preceding example that called for calculation of the number of days a proceeding was pending. In other words, “time consumed by appellate review” calls for the almost universal system for calculation of deadlines in courts and the USPTO, where the starting event from which the deadline is calculated is Day 0, and the succeeding days are assigned consecutive numbers until the day the deadline is reached.

The “time consumed by continued examination,” like the “time consumed by [an appeal, an interference, or a secrecy order],” all under 35 USC § 154(b)(1)(B), is expressed in different words than “each day of the pendency of

the proceeding order, or review," all under the provisions of 35 USC § 154(b)(1)(C), thus these two expressions in different parts of the same statutory section can be assumed to have different meanings as explained above.

In most situations, this is how the USPTO interprets the statute. For example, again based on USPTO petition practice experienced by the Applicant, when an appeal is prosecuted in an application that was pending more than three years, the USPTO subtracts appeal time from accrual of time under the three year guarantee by treating the date the Notice of Appeal is filed as Day 0, the date n days later when the appeal decision is mailed as Day n, simply determines that the appeal has been pending for n days, and subtracts n from the accrued time under the 3-year rule. To calculate the PTA accrued due to the prosecution of a successful appeal, however, the USPTO treats the starting date as Day 1, the date n days later when the appeal decision is mailed as Day n + 1, and determines that there were n+1 days on which the appeal was pending, and that is the PTA for appeal delay.

Now addressing consistency with other calculations, the subtraction from the three-year guarantee for an RCE is based on 35 USC § 154(b)(1)(B)(i), which calls for a subtraction based on "(i) any time consumed by continued examination of the application requested by the Applicant under section 132(b)." The subtraction from the three-year guarantee for an appeal is based on parallel language of 35 USC § 154(b)(1)(B)(ii), which calls for a subtraction based on "(ii) ... any time consumed by appellate review by the Board of Patent Appeals and Interferences." This parallel language calls for RCE subtraction and appeal subtraction to be based on the same method of time computation. But they are not.

As pointed out above, the filing date of an RCE is counted as Day 1 of reduction of PTA, so time stops accruing on the three-year guarantee the day before the RCE is filed. But the filing date of a Notice of Appeal is counted as Day 0 of reduction of PTA, so time stops accruing on the three-year guarantee the day the Notice of Appeal is filed. These positions are inconsistent interpretations of the same statutory language. The RCE computation is in error

because the statute calls for routine computation of time in both situations, with the starting day of a period counted as Day 0, while the USPTO position is that the day the RCE is filed is Day 1.

Another example of an inconsistency resulting from ending the three-year delay the day before the first RCE was filed is the following. The patent term adjustment under the Three Year Guarantee permanently stops accruing or is “capped” in two situations: when the patent issues or when the first RCE is filed. Based on experience with other patent term adjustment calculations, the Applicant understands the USPTO policy respecting issue of the patent is that the issue date of the patent is Day 0 that the patent term adjustment stops accruing. In other words, the PTA on this ground is capped on the day the patent issues, not the day before the patent issues. Exactly analogously to the issue date of the patent, the date an RCE is filed is a triggering event that caps the PTA. No reason is apparent why the issue date of a patent is Day 0 on which the PTA has been capped and the filing date of an RCE is day 1 after the PTA has been capped.

For these reasons, the USPTO policy for calculation of the effect of filing an RCE on accrual of the three-year guarantee is in error, and provides a PTA one day shorter than it should be. Correction is respectfully requested.

Net Patent Term Adjustment

The changes requested by the Applicant to the USPTO patent term adjustment determination in the patent PTA decision are as follows:

Positive Patent Term Adjustment

- **Three Year Guarantee
(35 USC § 154(b)(1)(B))**

	Patent Term Adjustment (days)
USPTO Calculation	1111

Applicant Calculation	1112
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Conclusion

The Applicant requests modification of the patent term adjustment as indicated above. As shown in the enclosed modified version of the USPTO Patent Term Adjustment calculation on PAIR, the patent term adjustment proposed by the Applicant is thus 1190 days.

Please charge any fees or credit any overpayment of fees presently required to McAndrews, Held & Malloy, Ltd., Deposit Account No. 13-0017.

Respectfully submitted,

McANDREWS, HELD & MALLOY, LTD.

Date: January 3, 2011

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10/657,785 NETWORK SUPPORTING ROAMING, SLEEPING TERMINALS

12-02-
2010::12:23:06**Patent Term Adjustments**

Patent Term Adjustment (PTA) for Application Number: 10/657,785

Filing or 371(c) Date:	09-08-2003	Overlapping Days Between {A and B} or {A and C}:	22
Issue Date of Patent:	11-02-2010	Non-Overlapping USPTO Delays:	1738
A Delays:	649	PTO Manual Adjustments:	0
B Delays:	1111	Applicant Delays:	549
C Delays:	0	Total PTA Adjustments:	1189

Patent Term Adjustment History Explanation Of Calculations

Number	Date	Contents Description	PTO (Days)	APPL (Days)	Start
124.5	09-23-2009	PTA 36 Months	1111		0
124	11-02-2010	Patent Issue Date Used in PTA Calculation			0
123	10-05-2010	Export to Final Data Capture			0
122	10-04-2010	Dispatch to FDC			0
121	09-27-2010	Mail-Petition Decision - Dismissed			0
120	09-27-2010	Petition Decision - Dismissed			0
119	09-08-2010	Finished Initial Data Capture			0
118	07-28-2010	Petition Entered			0
116	08-02-2010	Application Is Considered Ready for Issue			0
115	07-28-2010	Issue Fee Payment Verified			0
114	07-28-2010	Issue Fee Payment Received			0
113	07-19-2010	Export to Initial Data Capture			0
112	07-16-2010	Mail Notice of Allowance			0
111	07-15-2010	Issue Revision Completed			0
110	07-15-2010	Document Verification			0
109	07-15-2010	Notice of Allowance Data Verification Completed			0
108	07-14-2010	Notice of Allowability			0
107	05-08-2010	Date Forwarded to Examiner			0

106	04-27-2010	Response after Non-Final Action	89	102
105	04-27-2010	Request for Extension of Time - Granted		0
104	04-15-2010	Mail Examiner Interview Summary (PTOL - 413)		0
103	04-12-2010	Examiner Interview Summary Record (PTOL - 413)		0
102	10-28-2009	Mail Non-Final Rejection		0
101	10-26-2009	Non-Final Rejection		0
100	10-06-2009	Date Forwarded to Examiner		0
99	09-24-2009	Amendment Submitted/Entered with Filing of CPA/RCE		0
98	10-06-2009	Date Forwarded to Examiner		0
97	09-24-2009	Request for Continued Examination (RCE)	65	91
96	10-06-2009	Disposal for a RCE / CPA / R129		0
95	09-24-2009	Request for Extension of Time - Granted		0
94	09-24-2009	Workflow - Request for RCE - Begin		0
93	09-22-2009	Mail Examiner Interview Summary (PTOL - 413)		0
92	09-21-2009	Examiner Interview Summary Record (PTOL - 413)		0
91	04-21-2009	Mail Final Rejection (PTOL - 326)		0
90	04-21-2009	Final Rejection		0
89	10-03-2008	Information Disclosure Statement considered		0
88	10-22-2008	Information Disclosure Statement considered		0
87	03-31-2009	Paralegal TD Not accepted		0
86	03-31-2009	Paralegal TD Not accepted		0
85	03-31-2009	Paralegal TD Not accepted		0
84	03-31-2009	Paralegal TD Not accepted		0
83	03-31-2009	Paralegal TD Not accepted		0
82	03-26-2009	Paralegal TD Accepted		0

81	03-26-2009	Paralegal TD Accepted		0
80	03-26-2009	Paralegal TD Accepted		0
79	03-26-2009	Paralegal TD Accepted		0
78	03-26-2009	Paralegal TD Accepted		0
77	03-24-2009	Paralegal TD Not accepted		0
76	03-24-2009	Paralegal TD Not accepted		0
75	03-24-2009	Paralegal TD Not accepted		0
74	03-24-2009	Paralegal TD Not accepted		0
73	03-24-2009	Paralegal TD Not accepted		0
72	01-15-2009	Terminal Disclaimer Filed	0	66
71	01-15-2009	Terminal Disclaimer Filed		0
70	01-15-2009	Terminal Disclaimer Filed		0
69	01-15-2009	Terminal Disclaimer Filed		0
68	01-15-2009	Terminal Disclaimer Filed		0
67	02-18-2009	Date Forwarded to Examiner		0
66	01-15-2009	Response after Non-Final Action	36	56
65	01-15-2009	Request for Extension of Time - Granted		0
64	01-12-2009	Mail Examiner Interview Summary (PTOL - 413)		0
63	01-08-2009	Examiner Interview Summary Record (PTOL - 413)		0
62	10-22-2008	Reference capture on IDS		0
61	10-22-2008	Information Disclosure Statement (IDS) Filed		0
60	10-03-2008	Reference capture on IDS		0
59	10-03-2008	Information Disclosure Statement (IDS) Filed		0
58	10-22-2008	Information Disclosure Statement (IDS) Filed		0
57	10-03-	Information Disclosure Statement (IDS) Filed		0

	2008			
56	09-10-2008	Mail Non-Final Rejection		0
55	09-08-2008	Non-Final Rejection		0
54	08-19-2008	Date Forwarded to Examiner		0
53	08-08-2008	Amendment after Final Rejection	89	48
52	08-08-2008	Request for Extension of Time - Granted		0
51	07-17-2008	Mail Miscellaneous Communication to Applicant		0
50	07-17-2008	Miscellaneous Communication to Applicant - No Action Count		0
48	02-11-2008	Mail Final Rejection (PTOL - 326)	22	36
47	02-04-2008	Final Rejection		0
46	11-08-2007	Information Disclosure Statement considered		0
45	11-08-2007	Miscellaneous Incoming Letter		0
44	11-08-2007	Reference capture on IDS		0
43	11-08-2007	Information Disclosure Statement (IDS) Filed	49	36
38	11-08-2007	Information Disclosure Statement (IDS) Filed		0
37	09-25-2007	Date Forwarded to Examiner		0
36	09-20-2007	Response after Non-Final Action	92	34
35	09-20-2007	Request for Extension of Time - Granted		0
34	03-20-2007	Mail Non-Final Rejection		0
33	03-16-2007	Non-Final Rejection		0
29	10-11-2006	Information Disclosure Statement considered		0
28	03-06-2007	Information Disclosure Statement considered		0
27.7	03-06-2007	Information Disclosure Statement (IDS) Filed	68	25
27	03-06-2007	Information Disclosure Statement (IDS) Filed		0
26	01-14-2007	Date Forwarded to Examiner		0

25	12-28-2006	Response after Non-Final Action	61	22
24	12-28-2006	Request for Extension of Time - Granted		0
23.7	10-11-2006	Information Disclosure Statement (IDS) Filed		0
23	10-11-2006	Information Disclosure Statement (IDS) Filed		0
22	07-28-2006	Mail Non-Final Rejection	627	-1
21	07-24-2006	Non-Final Rejection		0
20	08-22-2005	Information Disclosure Statement considered		0
19	06-03-2006	Information Disclosure Statement considered		0
18	06-03-2006	Reference capture on IDS		0
17.7	06-03-2006	Information Disclosure Statement (IDS) Filed		0
17	06-03-2006	Information Disclosure Statement (IDS) Filed		0
16	03-21-2006	Case Docketed to Examiner in GAU		0
15	08-30-2005	IFW TSS Processing by Tech Center Complete		0
14.7	08-22-2005	Information Disclosure Statement (IDS) Filed		0
14	08-22-2005	Information Disclosure Statement (IDS) Filed		0
13	08-22-2005	Reference capture on IDS		0
12	10-25-2004	Miscellaneous Incoming Letter		0
11	07-18-2005	Case Docketed to Examiner in GAU		0
10	04-27-2005	Miscellaneous Incoming Letter		0
9	09-08-2003	Preliminary Amendment		0
8	12-19-2003	Application Dispatched from OIPE		0
7	12-22-2003	Application Is Now Complete		0
4	11-20-2003	CASE CLASSIFIED BY OIPE		0
3	11-20-2003	Cleared by OIPE CSR		0
2	11-02-2003	IFW Scan & PACR Auto Security Review		0

1	09-08- 2003	Initial Exam Team nn	0
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Close Window

PATENT TERM ADJUSTMENT SPREADSHEET

Ser. No. 10/657785

Docket No. 14206US03

		USPTO CALCULATION		APPLICANT'S CALCULATION	
DATE	EVENT	PTO Delay	Appl. Delay	PTO Delay	Appl. Delay
11/2/2010	Patent Grant date				
10/5/2010	Export to Final Data Capture				
10/4/2010	Dispatch to FDC				
9/27/2010	Mail-Petition Decision - Dismissed				
9/27/2010	Petition Decision - Dismissed				
9/8/2010	Finished Initial Data Capture				
8/2/2010	Application Is Considered Ready for Issue				
7/28/2010	Petition Entered				
7/28/2010	Issue Fee Payment Verified				
7/28/2010	Issue Fee Payment Received				
7/19/2010	Export to Initial Data Capture				
7/16/2010	Mail Notice of Allowance				
7/15/2010	Issue Revision Completed				
7/15/2010	Document Verification				
7/15/2010	Notice of Allowance Data Verification Completed				
7/14/2010	Notice of Allowability				
5/8/2010	Date Forwarded to Examiner				

1/15/2009	Request for Extension of Time - Granted			
1/12/2009	Mail Examiner Interview Summary (PTOL - 413)			
1/8/2009	Examiner Interview Summary Record (PTOL - 413)			
12/10/2008	Three months after Office action			
10/22/2008	Information Disclosure Statement considered			
10/22/2008	Reference capture on IDS			
10/22/2008	Information Disclosure Statement (IDS) Filed			
10/22/2008	Information Disclosure Statement (IDS) Filed			
10/3/2008	Information Disclosure Statement considered			
10/3/2008	Reference capture on IDS			
10/3/2008	Information Disclosure Statement (IDS) Filed			
10/3/2008	Information Disclosure Statement (IDS) Filed			
9/10/2008	Mail Non-Final Rejection			
9/8/2008	Non-Final Rejection			
8/19/2008	Date Forwarded to Examiner Amendment after Final Rejection			
8/8/2008				89
8/8/2008	Request for Extension of Time - Granted			

		89.00

7/17/2008	Mail Miscellaneous Communication to Applicant			
7/17/2008	Miscellaneous Communication to Applicant - No Action Count			
5/11/2008	Three months after Office action			
2/11/2008	Mail Final Rejection (PTOL - 326)	22		
2/4/2008	Final Rejection			
1/20/2008	Four months after response			
11/8/2007	Information Disclosure Statement considered			
11/8/2007	Miscellaneous Incoming Letter			
11/8/2007	Reference capture on IDS			
11/8/2007	Information Disclosure Statement (IDS) Filed		49	
11/8/2007	Information Disclosure Statement (IDS) Filed			
9/25/2007	Date Forwarded to Examiner			
9/20/2007	Response after Non-Final Action		92	
9/20/2007	Request for Extension of Time - Granted			
6/20/2007	Three months after Office action			
3/20/2007	Mail Non-Final Rejection			
3/16/2007	Non-Final Rejection			

	22.00			
	-22.00			
			49.00	
			92.00	

3/6/2007	Information Disclosure Statement considered				
3/6/2007	Information Disclosure Statement (IDS) Filed			68	68.00
3/6/2007	Information Disclosure Statement (IDS) Filed				
1/14/2007	Date Forwarded to Examiner				
12/28/2006	Response after Non-Final Action			61	61.00
12/28/2006	Request for Extension of Time Granted				
10/28/2006	Three months after Office action				
10/11/2006	Information Disclosure Statement considered				
10/11/2006	Information Disclosure Statement (IDS) Filed				
10/11/2006	Information Disclosure Statement (IDS) Filed				
9/8/2006	Three year date				
7/28/2006	Mail Non-Final Rejection		627		627.00
7/24/2006	Non-Final Rejection				
6/3/2006	Information Disclosure Statement considered				
6/3/2006	Reference capture on IDS				
6/3/2006	Information Disclosure Statement (IDS) Filed				
6/3/2006	Information Disclosure Statement (IDS) Filed				
3/21/2006	Case Docketed to Examiner in GAU				

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